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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/640,369	08/17/2000	Victoria J. Freeman	0065292	5206

7590 03/12/2003

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EXAMINER

ASHBURN, STEVEN L

ART UNIT PAPER NUMBER

3714

DATE MAILED: 03/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/640,369

Applicant(s)

FREEMAN, VICTORIA J.

Examiner

Steven Ashburn

Art Unit

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 December 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

## ***DETAILED ACTION***

### ***Claim Objections***

The objection to the claims is withdrawn.

### ***Claim Rejections - 35 USC § 112***

The rejection of Claim 6 is rejected under 35 U.S.C. 112, second paragraph is withdrawn.

### ***Claim Rejections - 35 USC § 103***

Claims 1-4, 6-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Peppel* in view of *McGuire*, U.S. Patent 1,379,871 (May 31, 1921) and *Schoolfield*, U.S. Patent 1,991,468 (Feb. 19, 1935).

This holding, incorporated herein, is maintained from the prior action for the cited claims as amended. Response to the applicant's remarks are provided below and incorporated herein.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over *Peppel* in view of *McGuire* and *Schoolfield*, as applied to claims 1-4, 6-25 above, in further view of *Naeve*, U.S. Patent 4,309,835 (Jan. 12, 1982).

This holding, incorporated herein, is maintained from the prior action for the cited claims as amended. Response to the applicant's remarks are provided below and incorporated herein.

### ***Response to Arguments***

Applicant's arguments filed Dec. 21, 2002 have been fully considered but they are not persuasive. The applicant asserts that the claims, as amended, distinguish over the prior art for the following reasons:

- a. *Peppel* does not teach or suggest game pieces based on literary works comprising a correctly ordered sequence of words.

Art Unit: 3714

b. *Peppel* does not teach or suggest a competition having the particular combination of features including a plurality of playing pieces are generated comprising a distinct part of a literary work; a corresponding advertisement unrelated to the literary work wherein the literary work comprises a plurality of words in a particular sequence; no identifier that would permit a participant to arrange the pieces in the correct order; distributing the pieces to computers over the internet; and, in response to receiving a correctly ordered set of player pieces that represent the correct sequence of words in the literary work, awarding a prize.

c. *McGuire* and *Schoolfield* do not teach or suggest a method of conducting a competition.

The examiner respectfully disagrees.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). The standard of patentability is what the prior art at a time prior to the invention, when taken as a whole, suggests to an artisan.

In this case, *Peppel* discloses a trading card system in which players compete to collect sets of electronic cards (i.e. game pieces) using computers linked to networks. See *fig. 2; col. 3:33-57*. The cards may be used in puzzle games wherein each card represents a piece of a set that must be collected and linked with other cards to win a prize. See *col. 5:28-30, 6:11-21*. In some embodiments, the cards represent distinct parts of a story such as motion pictures or other narratives. See *col. 11:23-42*. Also, cards may contain advertisement data unrelated to the story. See *col. 5:12-32, 7:48-57*. Additionally, the cards may be distributing to computers over the Internet. See *fig. 6 (220) col. 5:12-32, 7:48-57; 12:32, 7:48-57*.

*McGuire* discloses a puzzle game employing playing pieces that represent distinct parts of a complete plot, theme or story, wherein the plurality of playing pieces contain no readily identifiable

Art Unit: 3714

means for determining the correct sequence. *See p. 1, lines 9-30. McGuire* suggests a game having pieces forming a story wherein no identifier that would permit a participant to arrange the pieces in the correct order would be interesting and give rise to amusing mistakes and thereby create much merriment. *See p. 2, line 34-39.*

*Schoolfield* discloses a game having a pieces generated from distinct part of a literary works including legends, stories, poems, books and other forms of literature are selected and scenes drawn from the literature are depicted on cards wherein participants must assemble sets of cards based on literary work comprising a correctly ordered sequence of words. *See col. 1:15-35, 4:4-9. Schoolfield* suggests the use of literary works excites the imagination of players and stimulates a desire to read literature. *See col. 1:15-19.*

Thus, when taken as a whole, the combination of *Peppel* with *McGuire* and *Schoolfield*, suggests to an artisan at a time prior to the invention a collection game having a plurality of playing pieces comprising a distinct part of a literary work wherein the literary work comprises a plurality of words in a particular sequence; advertisements unrelated to the literary work; no identifier that would permit a participant to arrange the pieces in the correct order; distributing the pieces to computers over the Internet; and, in response to receiving a correctly ordered set of player pieces that represent the correct sequence of words in the literary work, awarding a prize.

### ***Conclusion***


**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the

Art Unit: 3714

date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven Ashburn whose telephone number is 703 305 3543. The examiner can normally be reached on Monday thru Friday, 8:00 AM to 4:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Hughes can be reached on 703-308-1806. The fax phone numbers for the organization where this application or proceeding is assigned are 703 872 9302 for regular communications and 703 872 9303 for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308 1078.

S.A.  
March 9, 2003

  
S. THOMAS HUGHES  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3700